

**REMARKS**

A. Present Claims

It is respectfully pointed out that the pending claims at the time of the Office Action were Claims 104, 112 to 117 and 124 to 141. Claims 105 to 111 and 118 to 123 were cancelled by the amendment mailed August 26, 2003.

B. § 112, 2<sup>nd</sup> Paragraph Rejection

Claims 104 to 141 are rejected as indefinite. The Examiner considers Claim 104 to be vague and indefinite because the final step does not adequately correspond to the preamble language which recites "Partially defatted cocoa solids". The Examiner points out that the final step i.e., (step d) in this product-by-process claim does not adequately define the partially defatted cocoa solids, *per se*. It is unclear to the Examiner if the recovered partially defatted cocoa solids is a separate product from the cocoa butter or if it is recovered as a mixture. The Examiner also states that it is unclear if one or both of the cocoa butter and/or partially defatted cocoa solids contain the cocoa polyphenols. The remaining claims are indefinite because they depend directly or indirectly on Claim 104.

In view of the amendment of Claim 104, it is believed the rejection is overcome. The cocoa butter is extracted from the cocoa nibs by pressing the nibs to expel the cocoa fat (referred to as "cocoa butter") from the cocoa nibs. After the pressing the partially defatted cocoa solids (also referred to as "cocoa cake") remain. Both the cocoa butter and partially defatted cocoa solids are recovered for subsequent use.

The cocoa solids, not the cocoa butter, contain the cocoa polyphenols. See Table 5 where the amounts of the various cocoa polyphenols present in both the inventive and conventionally processed cocoa cakes are reported. See also the discussion on page 59 regarding the chocolates prepared from the polyphenol-containing cocoa solids.

In view of the amendment of step (d) it is clear that it is the solids which contain the cocoa polyphenols. It is respectfully pointed out U.S. 6,737,088, also examined by Examiner Tate, similarly recites "recovering cocoa butter and cocoa solids which contain cocoa polyphenols".

C. Double Patenting Rejections

Claims 104-141 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-21 of U.S. Patent No. 6,297,273; over Claims 14-17 of U.S. Patent No. 6,312,753; over Claims 1-9 of U.S. Patent No. 6,372,267; and over Claims 1-15 of U.S. Patent No. 6,673,379. Although the conflicting claims are not identical, they are not patentably distinct from each other because each is drawn to a partially defatted cocoa solids product containing cocoa polyphenols (such as cocoa procyanidin pentamer) therein, and/or various conventional composition forms (e.g., pharmaceutical, good, drink, edible composition, etc.) comprising the partially defatted cocoa solids.

1. Rejection over Claims 1-21 of U.S. 6,297,273

It is respectfully submitted that the claimed partially defatted cocoa solids containing cocoa polyphenols are not obvious variants of the tableting and capsule filling compositions of the '273 patent. The fact that the claimed cocoa solids can be used in a tableting composition

that “can be pressed into a tablet” (as called for by Claims 1-10 of the ‘273 patent) does not make the products obvious variants. The capsule filling composition of the ‘273 patent “comprises partially defatted cocoa solids . . . which contain cocoa polyphenols . . . and filler” (emphasis added). Clearly, the presently claimed cocoa solids and the capsule filling composition of Claims 11-21 of the ‘273 patent differ due to the presence of a filler in the claimed capsule filling composition. Withdrawal of these rejections is respectfully requested.

2. Rejection over Claims 14-17 of U.S. 6,312,753

It is respectfully submitted that the claimed cocoa solids prepared from non-roasted cocoa nibs can not be obvious variants of the cocoa solids of Claims 14-16 which are “prepared from roasted cocoa beans or blends thereof having a fermentation factor of 275 or less” (emphasis added). The present claims call for “heating cocoa beans . . . to an internal temperature sufficient to loosen the cocoa shells without roasting the cocoa nibs. The cocoa solids of the ‘753 patent are conventionally processed cocoa solids. See the comparison in Table 5 of increased polyphenol content of cocoa solids prepared by the inventive process and the conventionally processed cocoa solids.

It is respectfully submitted that the presently claimed cocoa solids are not an obvious variant of food Claim 17 of the ‘753 patent. Claim 17 covers foods containing the conventionally processed cocoa solids of Claims 14, 15, and 16 which differ from the presently claimed cocoa solids for the reasons discussed above.

3. Rejection over Claim 1-9 of U.S. 6,372,267

It is respectfully submitted that the presently claimed partially defatted cocoa solids are not obvious variants of the food claims of the '267. They are part of the claimed food compositions which can be a chocolate flavored or a chocolate food product. It is not clear why the Examiner did not include the other food claims (i.e., Claims 10-15) in this rejection.

4. Rejection over Claims 1-15 of U.S. 6,673,379

It is respectfully submitted that Claims 104, 112 to 117, and 127-128 are not obvious variants of Claims 1-10 of the '379 patent which are directed to a drink comprising the cocoa solids currently claimed. The claimed drink is not a variant of the presently claimed cocoa solids. The drink is a composition which contains the claimed cocoa solids.

Claims 124 to 126 which recite specific uses for the cocoa solids in dietary, therapeutic, and veterinary compositions cannot be obvious over drinks for the reasons discussed above.

5. Cancellation of Claims 129-141

In view of the cancellation of the claims directed to edible compositions comprising, as part of the composition, the presently claimed cocoa solids, the rejections of these claims over certain claims of the '273, '573, '267, and '379 patents are moot.

D. Provisional Double Patenting Rejection

Claims 104-141 were provisionally rejected under the judicially-created doctrine of obviousness-type double patenting over the claims of copending Application No. 09/841,925, now U.S. Patent No. 6,737,088. The Examiner believes that although the conflicting claims are not identical, they are not patentably distinct from each other because both are drawn to partially defatted cocoa solids containing cocoa polyphenols and/or an extract obtained therefrom containing the cocoa polyphenols.

It is respectfully pointed out that the claimed cocoa solids cannot be obvious variants of the cocoa extracts when they are the starting material for making the cocoa extract. Withdrawal of the rejection of Claims 104, 112-117, and 124-128 is respectfully requested. Claims 129-141 are cancelled.

E. Closing

Entry of this amendment and withdrawal of the § 112 and obviousness-type double patenting rejections is respectfully requested. No new matter is presented.

Respectfully submitted,

Date:

July 23, 2004

Margaret B. Kelley  
Margaret B. Kelley  
Reg. No. 29,181

Clifford Chance US LLP  
31 West 52<sup>nd</sup> Street  
New York, NY 10019-6131  
Telephone: (212) 878-3145